



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/935,200 | 08/22/2001 | Roger C. Palmer | 077056-0353 | 8757 |

7590 05/03/2005

Anthony G Sitko
Marshall Gerstein & Borun
6300 Sears Tower
233 South Wacker Drive
Chicago, IL 60606-6357

EXAMINER

TRAN, HENRY N

ART UNIT

PAPER NUMBER

2674

DATE MAILED: 05/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/935,200

Applicant(s)

PALMER ET AL.

Examiner

HENRY N TRAN

Art Unit

2674

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

The RCE filed 3/21/05 has been considered in preparing this Office action.

1. The indicated allowability of claims 7, 18, 20, 21 and 27 is withdrawn in view of the newly discovered references to Fenton et al (U.S. Patent No. 6,343,264), Ringland et al (U.S. Patent No. 6,122,391) and Fujii et al (U.S. Patent No. 6,715,423). Rejections based on the newly cited references follow.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a) because they fail to show the reference numbers: 28, 30, 32 and 70 as described in paragraphs [0024] and [0032] of the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be

Art Unit: 2674

labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR

1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 16-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re claim 16, which recites the limitation "the selected decorative element" in line 5.

There is insufficient antecedent basis for this limitation in the claim.

Re claims 17, 19 and 22, which are dependent upon the base claim 16, and are therefore held insufficient antecedent basis for the same reason discussed for claim 16 above.

Re claim 18, which recites the limitation "the selected decorative element" in lines 6-7.

There is insufficient antecedent basis for this limitation in the claim.

Re claim 18, which uses the auxiliary verbs "can" and "might" in lines 12 and 13; and is held as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim.

Re claim 20, which recites the limitation "the selected decorative element" in lines 6-7.

There is insufficient antecedent basis for this limitation in the claim.

Re claim 21, which recites the limitation "the selected decorative element" in lines 6-7.

There is insufficient antecedent basis for this limitation in the claim.

Re claim 23, which recites the limitation "the decorative element sample" in line 5.

There is insufficient antecedent basis for this limitation in the claim.

Re claim 23, which recites the limitation "the selected decorative element" in line. There is insufficient antecedent basis for this limitation in the claim.

Re claim 27, which recites the limitation "the selected window covering sample" in line 5. There is insufficient antecedent basis for this limitation in the claim.

Re claim 27, which uses the auxiliary verbs "can" and "might" in lines 5 and 6; and is held as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim.

For the purpose of this Office action, the examiner assumes that:

(i) in claims 16, 18, 20, 21 and 23, the limitation "the selected decorative element" is changed to --a selected decorative element--;

(ii) in claim 23, the limitation "the decorative element sample" is changed to --a decorative element sample--;

(iii) in claim 27, the limitation "the selected window covering sample" is changed to --a selected window covering sample--; and

(iv) in claims 18 and 27, delete the use of the auxiliary verbs "can" and "might".

Art Unit: 2674

Applicant is required to amend the claims for overcoming the rejections in reply to this Office action.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-7 and 16-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Fenton et al (U.S. Patent No. 6,343,264, hereinafter referred to as "Fenton") in view of Fujii et al (U.S. Patent No. 6,715,423, hereinafter referred to as "Fujii").

6. Regarding claims 1-7, Fenton discloses a method of applying a decorative element to a window covering (window and wall coverings, column 2, lines 38-40), the method comprising the steps

of: providing decorative element data (color, column 2, lines 28-50); applying the decorative element according to the decorative element data to the window covering in a retail store (customer shopping, column 1, lines 65-66); wherein the decorative element is one of a color, image, pattern, and texture (color, column 2, lines 28-50) (claim 2); wherein the step of providing decorative element data includes selecting the decorative element from a database (product information database allows user selection, column 6, lines 6-17) (claim 3); wherein the step of providing decorative element data includes scanning a sample provided by a customer (scanner, column 4, lines 65-67) (claim 4); wherein the step of providing decorative element data

Art Unit: 2674

includes reading an electronic file provided by the user (computer hard drive, column 4, lines 10-11) (claim 5); wherein the step of displaying the decorative element includes applying to the window covering on a monitor (graphic display monitor 16, column 4, lines 4-5) (claim 6).

However, Fenton does not teach the step of physically applying the decorative element includes printing the decorative element onto a portion of the window covering. Fujii teaches an apparatus and methods for applying a decorative element (e.g., a color and design pattern selected by the user, see col. 8, lines 46-49) onto a portion of the wallpaper using a printer 23, see Figs. 8 and 16, col. 11, lines 6-9. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a printer for printing a decorative design pattern as taught by Fujii in the Fenton system because this would provide an improved manufacturing process for effectively and quickly producing selected decorative surface treatments desired by a computer user, or a customer in (see Fujii, abstract). By this rationale, claims 1-7 are rejected.

7. Regarding claims 16-22, Fenton further teaches the use of a computer 32 having graphics programs configured to store and recall a decorative element; a scanner 36; a display monitor for displaying window covering samples for selecting by the user (see col. 7, line 60 to col. 8, line 35). Fujii further teaches that: the user computer is coupled to a network having a server computer 21; the use of a printer, such as the ink-jet printer, which includes a magazine or an ink reservoir and a curing apparatus, which is an air blower (they are inherent elements available in the ink-jet printer) (see col. 6, lines 53-64). Claims 16-22 are therefore rejected.

8. Regarding claims 23-27, which comprise the same claim elements of claims 16-22, wherein, the computer is rephrased as a processor; also, software, such as graphics programs suggested by Fenton are read on rendering program and mapping program recited in claims 23

and 27. Claims 23-37 are therefore rejected on the same reasons set forth in claims 16-22 discussed above.

Claim Rejections - 35 USC § 103

9. Claims 8-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ringland et al (US Patent 6,122,391, hereinafter referred to as "Ringland") in view of "Fujii".

As to claim 8, Ringland et al. discloses a method for applying a decorative element to a window covering, the method comprising the steps of: providing a searchable data compilation of decorative elements on a storage device (database on CD-ROM, column 12, lines 55-56); displaying available decorative elements to a customer (GUI module, column 15, lines 45-46); obtaining a selection from the user (Graphical User Interface, column 15, lines 35-36), the selection comprising at least one of the decorative elements contained in the data compilation (steps 408/410 shown in figure 4); displaying images of the selected decorative element applied to the window covering (display color on monitor, column 6, lines 6-7) ; applying the selected decorative element to the window covering (customer chooses panel and confirms selection matching panel to fabric samples, column 7, lines 48-51).

However, Ringland does not teach the step of: physically applying the decorative element to the window covering.

Fujii teaches an apparatus and methods for applying a decorative element (e.g., a color and design pattern selected by the user, see col. 8, lines 46-49) to the wallpaper using a printer 23, see Figs. 8 and 16, col. 11, lines 6-9. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a printer for printing a decorative design pattern

Art Unit: 2674

as taught by Fujii in the Ringland system because this would provide an improved manufacturing process for effectively and quickly producing selected decorative surface treatments desired by a computer user, or a customer in (see Fujii, abstract). By this rationale, claim 8 is rejected.

As to claims 9-15, Ringland further teaches that the selected decorative element is one of color, an image, a pattern, a texture (pattern, column 20, lines 58-60) (claim 9); wherein the selected decorative element is applied to the window covering in a retail store customer chooses panel and confirms selection matching panel to fabric samples, column 7, lines 48-51, this implies location in a retail store is inherent) (claim 10); the step of scanning a sample (scanner, column 6, lines 49-51) (claim 11); the step of accessing a file containing the searchable data compilation image file on CD-ROM, column 7, lines 62-64) (claim 12); step of storing the searchable data compilation on a removable storage medium (database on CD-ROM, column 12, lines 55-56) (claim 13); wherein the removable storage medium is a CD-ROM (column 14, lines 12-16) (claim 14); and wherein the step of displaying images includes rendering at least one decorative material onto a computer model of the window covering (render/visualization module 340 in Fig. 3, rendering engine providing selected materials in a room image, column 18, lines 36-39, system can provide image of typical room, column 18, lines 14-16, this corresponds to the claimed computer model, render 810 shown in figure 8) (claim 15). Claims 9-15 are therefore rejected on the same reasons set forth for claim 8, and by the reasons noted above.

Response to Arguments

10. Applicant's arguments with respect to claims 1-27 have been considered but are moot in view of the new grounds of rejection.

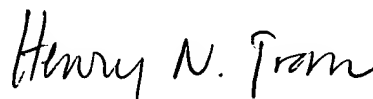
Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. They are U.S. Patents Nos.: 6459435 and 6354212, which teach computer systems and methods for providing decorative design pattern in manufacturing surface treatments for interior spaces or wallpaper panels.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HENRY N TRAN whose telephone number is 571-272-7760. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, PATRICK N EDOUARD can be reached on 571-272-7603. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



HENRY N TRAN
Primary Examiner
Art Unit 2674

4/28/05